

Application Serial No.: 09/754,378

Attorney Docket No. 24122-303-407

In Response to FINAL Office Action mailed October 10, 2003

### REMARKS

In response to the Final Office Action (Paper No. 12) mailed October 10, 2003, claims 76, 77, and 79 have been amended, and claims 90-112 have been newly added. No claims have been cancelled. Therefore, claims 76-112 are pending. Support for the instant amendments is provided throughout the as-filed Specification. Thus, no new matter has been added. In view of the foregoing amendments and following comments, allowance of all the claims pending in the application is respectfully requested.

#### Information Disclosure Statement (I.D.S.)

Applicants are submitting herewith an Information Disclosure Statement ("IDS"). Applicants respectfully request that the Examiner consider the cited references and provide a signed copy of the Form PTO-1449 for this submission with the next Office Action.

#### Non-Statutory Double Patenting Rejection

Claims 76-89 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 63-74 of co-pending U.S. Application Serial No. 09/321,597 (Attorney Docket No. 24122-303-403). Claims 76-81 and 83-89 stand rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-8 of U.S. Patent No. 6,321,208. *See* Final Office Action, pg. 2, ¶3. Applicants disagree with the rejections set forth by the Examiner. However, in an effort to expedite prosecution, Applicants may consider filing a Terminal Disclaimer upon the Examiner's indication of allowable subject matter.

#### Rejections Under 35 U.S.C. § 112, First Paragraph

Claim 82 stands rejected under 35 U.S.C. §112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the

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application was filed, had possession of the claimed invention. *See* Final Office Action, pg. 3,

¶4. In particular, the Examiner alleges that Applicant's specification does not disclose

*"...coupon is provided to the user via an electronic mail message."*

Applicants traverse this rejection. Support for this claim element may be found in *at least* the following exemplary citations to the Specification and/or drawing figures: FIG. 1; pg. 8, lines 11-15; pg. 10, lines 11-12 & 27-29; pg. 14, line 23 → pg. 15, line 8; pg. 15, line 27 → pg. 16, line 3; and page 20, lines 8-14. Accordingly, withdrawal of this rejection is earnestly sought.

### Rejections Under 35 U.S.C. §103

Claims 76-89 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 5,227,874 to Von Kohorn in view of U.S. Patent No. 5,734,823 to Saigh *et al.* ("Saigh"). *See* Final Office Action, pg. 4, ¶5. Applicants traverse this rejection.

Independent claim 76 includes the features of downloading to a user's remote terminal an incentive data management software module for managing the printing of incentives, and printing at the remote terminal, under control of the incentive data management software module, one or more user-selected incentives.

In the Final Office Action, at pgs. 4-5, the Examiner cites several passages in Von Kohorn which allegedly disclose, teach, or suggest these claim features. Applicants submit, however, that none of the passages relied upon by the Examiner in Von Kohorn appear to disclose, teach, or suggest the features of downloading to a user's remote terminal an incentive data management software module for managing the printing of incentives, and printing at the remote terminal, under control of the incentive data management software module, one or more user-selected incentives.

Von Kohorn, which is non-analogous art with respect to Applicants' invention, does not disclose a system and method for the electronic distribution of coupons over the Internet that can be printed and redeemed by a user. By contrast, Von Kohorn is primarily directed toward a method for evaluating the short and long term effectiveness of broadcast stimuli (*e.g.*, television and radio signals) and print stimuli on individuals (*e.g.*, shoppers). In various embodiments, Von Kohorn utilizes a custom response unit that may be placed in systematically or randomly selected

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homes, used for desired research purposes and thereupon moved to new locations. *See* Von Kohorn, *e.g.*, col. 20, lines 8+. Consumers may, in response to answering questions or following other instructions during a broadcast, receive inducements (*e.g.*, coupons). Such inducements may be outputted via a special dispenser associated with the custom response units. In at least some embodiments, an inducement is printed on a special matrix.

Von Kohorn does not, as recited above, appear to disclose, teach, or suggest *at least* downloading to a user's remote terminal an incentive data management software module for managing the printing of incentives, and printing at the remote terminal, under control of the incentive data management software module, one or more user-selected incentives. The Examiner also acknowledges that Von Kohorn fails to disclose the Internet as a communication channel. *See* Final Office Action, pg. 6. Nor do the majority of the Von Kohorn embodiments use a general purpose computer.

Assuming *arguendo* that there was a teaching, suggestion, or motivation to modify Von Kohorn to include the teachings of Saigh, the rejection would still be improper. The two references, even if combined, fail to disclose, teach or suggest all of the claim elements.

In particular, the deficiencies of Von Kohorn are not remedied by Saigh. For example, Saigh does not appear to disclose *at least* downloading to a user's remote terminal an incentive data management software module for managing the printing of incentives, and printing at the remote terminal, under control of the incentive data management software module, one or more user-selected incentives. Saigh discloses a communication network for distributing information between a central information bank and a central transactional data base coupled to point-of-sale delivery systems. Although the point-of-sale delivery system may, in one embodiment, take the form of a promotional delivery system (*see* Saigh, *e.g.*, col. 14, lines 15+), Saigh does not appear to disclose, teach or suggest *at least* the aforementioned features. Many other differences exist between the invention and Saigh. Additionally, Saigh is not analogous to the claimed invention, and no legally proper suggestion to combine Von Kohorn and Saigh has been set forth.

For at least the reasons set forth above, Applicants submit that none of the references cited by the Examiner, either alone or in combination, teach all of the limitations of independent claim 76. Accordingly, Applicants further submit that dependent claims 77-111 are allowable

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because they depend from an allowable independent claim, as well as for the further limitations they contain.

New claims

Applicants further submit that none of the references cited by the Examiner, either alone or in combination, teach all of the limitations of newly added independent claim 112.

CONCLUSION

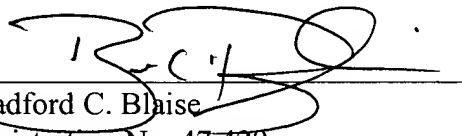
Having addressed each of the foregoing rejections, it is respectfully submitted that a full and complete response has been made to the outstanding Office Action and, as such, the application is in condition for allowance. Notice to that effect is respectfully requested.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Respectfully submitted,

Date: April 7, 2004

By:

  
Bradford C. Blaise  
Registration No. 47,429

MINTZ, LEVIN, COHN, FERRIS, GLOVSKY, AND POPEO, PC  
12010 Sunset Hills Road  
Suite 900  
Reston, Virginia 20190  
(703) 464-4800 (Telephone)  
(703) 464-4895 (Facsimile)